

### Remarks

Claims 7-8 and 11-12 are pending in the present application after cancellation of claims 9-10. Claim 7 has been amended.

Claims 9 and 10 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. In particular, the Examiner contends that the “balancing element” is not described in detail, and that the “balancing element” is not well known in the art. Applicants respectfully submit that the “balancing element” is indeed well known in the art, as evidenced by its ubiquitous usage in numerous U.S. patents, and there is no question that one of ordinary skill in the art would readily understand how to make or use the claimed element without undue experimentation. However, in order to expedite the prosecution of main claim 7 of the present application, Applicants have deleted claims 9 and 10, thereby obviating the enablement issue at this point.

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Claims 7 and 8 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,836,144 ("Yang"). Applicants respectfully submit that the pending claims 7 and 8 are allowable over Yang for the following reasons.

To anticipate a claim under § 102(e), a single prior art reference must identically disclose each and every claim element. See Lindeman Maschinenfabrik v. American Hoist and Derrick, 730 F.2d 1452, 1458 (Fed. Cir. 1984). If any claimed element is absent from a prior art reference, it cannot anticipate the claim. See Rowe v. Dror, 112 F.3d 473, 478 (Fed. Cir. 1997). Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claim invention, arranged exactly as in the claim. Lindeman, 703 F.2d 1458 (Emphasis added). Additionally, not only must each of the claim limitations be identically disclosed, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the inventions of the rejected claims, as discussed above. See Akzo, N.V. v. U.S.I.T.C., 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986). To the extent that the Examiner may be relying on the doctrine of inherent disclosure for the anticipation rejection, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

Amended claim 7 recites, in relevant parts, “a first terminating resistor and a second terminating resistor provided between the two wires of the two-wire line, wherein the first and the second terminating resistors are connected in series; and at least one switching arrangement provided between the first and second terminating resistors, wherein the at least one switching arrangement is configured to selectively separate the first and second terminating resistors from the two-wire line.” The amended feature is clearly described in the original Specification, e.g., at p. 3, l. 30 – p. 4, l. 8, as well as clearly shown in Fig. 1. In contrast to the present claimed invention of claim 7, the circuitry disclosed in Yang always includes a termination resistance  $R_{\text{TERM}}$ , and there is absolutely no suggestion to “selectively separate the first and second terminating resistors from the two-wire line.” This difference will be explained in further detail below.

Yang discloses a circuitry for implementing a termination resistor  $R_{\text{TERM}}$  (102 in Figure 1) by a series of four resistance elements, i.e.,  $R_1$ ,  $R(T1)$ ,  $R_2$  and  $R(T2)$ , (column 3, line 1-10 and 29-32), so the terminating resistor  $R_{\text{TERM}}$  is always present. The stated goal of the circuit disclosed in Yang is to provide a terminating resistor that is constant within a narrow tolerance range while minimizing the circuit complexity, (see, e.g., column 1, lines 28-37 and 42-48 and 59-61), and the transistor channel resistances  $R(T1)$  and  $R(T2)$  are used to achieve the needed precision within the narrow tolerance range. Although the resistances  $R_1$  and  $R_2$  could alternatively be left out, at least  $R(T1)$  and  $R(T2)$  are always used for the termination resistance  $R_{\text{TERM}}$  which is not separated from the bus lines under any circumstance.

For at least the foregoing reasons, claim 7 and its dependent claim 8 are not anticipated by Yang.

Claim 11 was rejected under 35 U.S.C. §103(a) as being unpatentable over Yang in view of U.S. Patent No. 6,853,213 (“Funaba”). Applicants respectfully submit that the combination of Yang and Funaba does not render obvious claim 11 for the following reasons.

In rejecting a claim under 35 U.S.C. §103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three

criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091 (Fed. Cir. 1986). Third, the prior art references must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). To the extent that the Examiner may be relying on the doctrine of inherent disclosure to support the obviousness rejection, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

Claim 11 ultimately depends on amended claim 7. As noted above, Yang clearly fails to anticipate amended claim 7. Furthermore, the teachings of Funaba clearly fail to remedy the deficiencies of Yang as applied against parent claim 7. Accordingly, the overall teachings of Yang and Funaba fail to render dependent claim 11 obvious, and withdrawal of the obviousness rejection is requested.

Claim 12 was rejected under 35 U.S.C. §103(a) as being unpatentable over Yang in view of U.S. Patent No. 6,922,073 (“Haase”). Applicants respectfully submit that the combination of Yang and Haase does not render obvious claim 12 for the following reasons.

Initially, Applicants note that Haase is not a valid prior art reference as applied against the present application. The earliest effective priority date of the present application is December 30, 2002 (the filing date of the priority German application), and the earliest effective U.S. filing date of the present application is December 16, 2003 (the filing date of the parent PCT application). Since Haase was first published on July 1, 2004, Haase is clearly not a §102(b) reference against the present application. Furthermore, for the purposes of §§102(a) and (e), the earliest effective filing date of Haase is its U.S. filing date, October 30, 2003, which is after the earliest effective priority date of the present application, December 30, 2002. Accordingly, Haase is clearly not a §102(a) or (e) reference against the present application. Therefore, Haase is not a valid prior art reference against the present

application. Since Yang clearly does not teach or suggest all of the features of claim 12, Applicants submit that the present rejection of claim 12 should be withdrawn.

Independent of the above, claim 12 depends on amended claim 7. As noted above, Yang clearly fails to anticipate amended claim 7. Furthermore, the teachings of Haase clearly fail to remedy the deficiencies of Yang as applied against parent claim 7. Accordingly, even if Haase were a valid prior art reference, the overall teachings of Yang and Haase fail to render dependent claim 12 obvious, and withdrawal of the obviousness rejection is requested.

### **CONCLUSION**

Applicants respectfully submit that all pending claims 7, 8, 11 and 12 of the present application are now in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited.

Respectfully submitted,

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